

REMARKS

The Applicants have studied the Office Action dated August 3, 2006. Claims 2-4 have been amended. Claims 1, and 15-21 have been cancelled without prejudice. Claims 2-14 remain pending. In the Office Action the Examiner:

- acknowledges the Applicants provisionally elect for continued prosecution of the Group I claims (i.e., claims 1-14) to a mailing form;
- rejected claims 1-14 under 35 U.S.C. 112, ¶ 2, as being indefinite;
- rejected claim 1 under 35 U.S.C. 103(a) as being unpatentable over Volkert (U.S. 5,687,495); and
- indicated the allowable subject matter of claims 2-14.

Election / Restriction

As noted above In response to the restriction requirement under 35 U.S.C. § 121, the Examiner acknowledges the Applicants provisionally elect for continued prosecution of the Group I claims (i.e., claims 1-14) to a mailing form. Thus, Applicants request examination of claims 1-14.

To advance the prosecution of the application, claims 15 - 22 have been canceled without prejudice or disclaimer. Applicants expressly reserve the right to file a divisional application with respect to these claims at a later date.

Objection to Claims 1, 2, and 4 for Informalities

As noted above, the Examiner objected to claims 1, 2 and 4 for various informalities. The Applicants have cancelled claim 1 and combine claim 1 with claim 2. The Applicants have carefully amended claims 2 - 4 to correct the antecedent basis. The Applicants respectfully submit that the Examiner's objection to claims 1, 2, and 4 have been overcome and respectfully request the Examiner's objection be withdrawn.

35 U.S.C. 112, ¶ 2

As noted above, the Examiner rejected claims 1-14 under 35 U.S.C. 112, ¶ 2, as being indefinite. Claim 1 has been cancelled without prejudice or disclaimer. The Applicants have cancelled claim 1 and combine claim 1 with claim 2. The Applicants have carefully amended claims 2, 3, 4, and 8 to particularly point out and distinctly claim the subject matter which the Applicants regards as the invention. Specifically, independent claim 2 now recites

a bottom ply of the mailing form with a first side and a second side;

a top ply of the mailing form with a first side and a second side, wherein the second side of the top ply is located over and facing the first side of the bottom ply;

This is shown in FIGs 1- 12 of the current invention. Further, all reference to "top", "back", "inside" have been replaced with "first side" or "second side" of the bottom ply and "first side" or "second side" of the top ply. In claim 5, the term "left side" has been replaced with "a first portion". The Applicants respectfully submit that the Examiner's rejection to claims 1-14 have been overcome and the Examiner's rejection should be withdrawn.

35 U.S.C. 103(a) in view of Volkert

As noted above, the Examiner rejected claim 1 under 35 U.S.C. 103(a) as being unpatentable over Volkert (U.S. 5,687,495). Claim 1 has been cancelled without prejudice or disclaimer. Accordingly, the Examiner's rejection of claim 1 has been rendered moot.

Allowable Subject Matter

The Applicants also wish to thank Examiner Henderson for indicating the allowable subject matter of claims 2-14. Although the Applicants respectfully disagree with the Examiner's rejection of independent claim 1, the Applicants have elected to cancel independent claim 1 solely for the purpose of expediting the patent application process in a manner consistent with PTO's Patent Business Goals (PBG), 65 Fed. Reg. 54603 (September 8, 2000). Claims

2-14 as now presented contain only those limitations of originally filed claims 2-14. Therefore, this amendment does not narrow the scope of claims 2-14 within the meaning of Festo.¹

CONCLUSION

The prior art made of record and not relied upon was reviewed and Applicants believe that such prior art is not pertinent to Applicants' disclosure.

No amendment made was related to the statutory requirements of patentability unless expressly stated herein. No amendment made was for the purpose of narrowing the scope of any claim, unless Applicants have argued herein that such amendment was made to distinguish over a particular reference or combination of references.

Applicants acknowledge the continuing duty of candor and good faith to disclose information known to be material to the examination of this application. In accordance with 37 CFR §1.56, all such information is dutifully made of record. The foreseeable equivalents of any territory surrendered by amendment are limited to the territory taught by the information of record. No other territory afforded by the doctrine of equivalents is knowingly surrendered and everything else is unforeseeable at the time of this amendment by the Applicants and their attorneys.

The Commissioner is hereby authorized to charge any fees that may be required or credit any overpayment to Deposit Account 50-1556.

In view of the preceding discussion, it is submitted that the claims are in condition for allowance. Reconsideration and re-examination is requested.

¹ Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd., No. 00-1543 (122 S. Ct. 1831; 2002 U.S. LEXIS 3818; 62 U.S.P.Q.2D (BNA) 1705)(Decided May 28, 2002).

PLEASE CALL the undersigned if the Examiner believes that there are any informalities that can be corrected by Examiner's amendment, or that in any way it would help expedite the prosecution of the patent application.

Respectfully submitted.

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